

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 2,772,766)	
For the Mark SAN DIMAS GUITARS THE)	
CALIFORNIA GUITAR COMPANY (Design))	
Registration Date: October 7, 2003)	
)	
JACKSON/CHARVEL MANUFACTURING, INC.,)	Cancellation No. 92042614
)	
Petitioner,)	
)	
v.)	
)	
PRINS, LLOYD A., Registrant-Respondent.)	

PETITIONER'S STATEMENT OF MATERIAL UNDISPUTED FACTS

Petitioner Jackson/Charvel Manufacturing, Inc. ("JCMI"), by its undersigned counsel, submits this Statement of Material Undisputed Facts, supported by appropriate citations to the record, including declarations. Although Respondent Lloyd A. Prins ("Prins") submitted a Statement of Material Facts along with his motion for summary judgment, Prins' "facts" are not material and do not bear on this proceeding. (*See* Petitioner's Response to Registrant's Statement of Material Facts Not In Dispute, filed contemporaneously herewith.) Accordingly, in lieu of a Statement of Genuine Issues, JCMI has submitted a counter Statement of Material Undisputed Facts. It is obvious from the undisputed facts detailed herein that JCMI disputes Prins' conclusory allegations concerning priority and distinctiveness.

I. JCMI HAS STANDING TO PURSUE THIS CANCELLATION PROCEEDING

1. Prins is currently selling guitars in connection with his designation SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY in competition with JCMI. (*See* Declaration of John Walker [hereinafter "Walker Decl."], attached as Exhibit 4 to Petitioner's Response in Opposition to Registrant's Motion for Summary Judgment [hereinafter "JCMI's Response Brief"], at ¶ 6.) JCMI and Prins are competitors. (*See id.*)

2. On October 11, 2003, JCMI filed a federal trademark application for the mark SAN DIMAS. (*See* Declaration of Oscar L. Alcantara, Esq. [hereinafter "Alcantara Decl."], attached as Exhibit 5 to JCMI's Response Brief, at ¶ 3.)

3. On April 30, 2004, the trademark examining attorney issued a non-final office action, citing Lloyd A. Prins' supplemental registration, U.S. Suppl. Reg. No. 2,772,766, as a potential bar to registration of JCMI's SAN DIMAS mark. (*See id.* at ¶ 4.)

4. On April 12, 2005, the trademark examining attorney issued a suspension letter concerning *ex parte* prosecution of JCMI's SAN DIMAS mark. (*See id.* at ¶ 5.) Accordingly, proceedings on Jackson/Charvel's SAN DIMAS mark application, U.S. Trademark Serial No. 78/312,464, have been suspended pending the outcome of this Cancellation Proceeding. (*See id.*)

II. JACKSON/CHARVEL HAS PRIORITY OVER PRINS

5. As early as June 1993, the Jackson/Charvel division of International Music Company ("IMC"), JCMI's predecessor in interest, began using the mark SAN DIMAS in connection with the sale of electric guitars and guitar parts. (*See* Declaration of Donald Wade [hereinafter "Wade Decl."], attached as Exhibit 1 to JCMI's Response Brief, at ¶ 7.) In approximately 1997, Akai Musical Instruments Corporation ("AMIC") purchased IMC and its Jackson/Charvel division, which included its line of guitar products and marks. (*See id.* at ¶ 4.) In October 2002, JCMI, a subsidiary of Fender Musical Instruments Corporation ("FMIC"), purchased certain assets of the Jackson/Charvel division of AMIC, which included its electric guitar and bass product lines and intellectual property. (*See* Declaration of Mark Van Vleet [hereinafter "Van Vleet Decl."], attached as Exhibit 3 to JCMI's Response Brief, at ¶ 2; *see also* Wade Decl. at ¶ 4.)

6. JCMI consummated its purchase of certain assets from Jackson/Charvel on October 25, 2002, pursuant to the terms of a Purchase and Sales Agreement between JCMI and AMIC. (*See* Van Vleet Decl. at ¶ 2.) As part of the transaction, AMIC assigned Jackson/Charvel's intellectual property rights, including its "entire right title and interest in the common law rights, goodwill or other rights to trademarks and tradenames used by AKAI Musical Instrument Corporation in its Jackson/Charvel Division," to JCMI on October 25, 2005. (*See id.*) Accordingly, JCMI is the successor in interest to AMIC's Jackson/Charvel division and owns all of the intellectual property rights associated with Jackson/Charvel's guitar and bass products.¹ (*See id.*) Obtaining these intellectual property rights was an important factor in JCMI's decision to enter into the Purchase Agreement. (*See id.*)

7. In 1993 Jackson/Charvel began using the mark SAN DIMAS in connection with the sale of electric guitars and parts, specifically guitar necks. (*See* Wade Decl. at ¶ 7.) Jackson/Charvel exhibited the SAN DIMAS guitar at the Winter NAMM trade show in 1994. (*See id.*) Some of the hallmark features of Jackson/Charvel's SAN DIMAS guitars are the "hot rod" style of the guitar, a body made of exotic wood, and a specifically shaped bolt-on guitar neck. (*See id.*) Certain of Jackson/Charvel's guitars were named "SAN DIMAS I," "SAN DIMAS II," "SAN DIMAS III," "SAN DIMAS IV," and "SAN DIMAS V." (*See id.* at ¶ 9.)

8. Jackson/Charvel has continuously offered SAN DIMAS guitars and parts for sale using the SAN DIMAS mark from 1993 to the present. (*See id.* at ¶ 7.)

9. The SAN DIMAS mark was used on point-of-sale displays in connection with the sale of electric guitars. (*See id.* at ¶ 9.) Such point-of-sale displays were laminated and used by retailers in direct association with the sale of Jackson/Charvel's SAN DIMAS guitars. (*See id.*) Customers at a guitar shop could view the laminated display near the counter or in

¹ JCMI and all of its predecessors in interest are referred to herein as "Jackson/Charvel" for ease of reference.

close proximity to a SAN DIMAS guitar hanging on the wall at a Jackson/Charvel retailer's music store. (*See id.*)

10. In addition, Jackson/Charvel used the SAN DIMAS mark in connection with guitar parts, specifically bolt-on necks, in widely distributed catalogs. (*See id.* at ¶ 10.) Retailers and customers could and did order guitars with SAN DIMAS guitar necks by using the order forms in the back of these catalogs. (*See id.*) Approximately 25,000 catalogs a year were sent to Jackson/Charvel's retailers and customers. Customers would and did order SAN DIMAS guitar necks as part of a custom-model guitar. (*See id.*)

11. Jackson/Charvel also devoted a significant amount of advertising resources to its SAN DIMAS guitars. (*See id.* at ¶ 8.) Jackson/Charvel spent tens of thousands of dollars advertising its SAN DIMAS guitars in print media. (*See id.*) One of Jackson/Charvel's bigger product roll-outs and advertising buys for any guitar in the CHARVEL line was the roll-out of Jackson/Charvel's SAN DIMAS guitars. (*See id.*) For example, Jackson/Charvel advertised its SAN DIMAS guitars in popular guitar magazines, such as *Guitar World* and *Guitar*, which are widely distributed to consumers of electric guitars across the nation. (*See id.*)

12. Jackson/Charvel also advertised in promotional brochures provided to its retailers and customers. (*See id.*) Jackson/Charvel distributed approximately 8,000 to 10,000 copies of these promotional brochures to its customers and retailers annually. (*See id.*)

13. Based in part on its advertising and promotion of the SAN DIMAS mark, Jackson/Charvel sold approximately \$750,000 of SAN DIMAS guitars during the 1990s. (*See id.* at ¶ 11.)

14. Jackson/Charvel continued to offer its SAN DIMAS guitars and guitar parts for sale from 2000 through the present in Jackson/Charvel's custom shop, which is the longest continuously operating guitar custom shop in the United States. (*See id.*)

15. Jackson/Charvel also advertised SAN DIMAS guitars on its custom shop website. (*See id.*)

16. From 1993 through the present, a consumer has always been able to buy a SAN DIMAS guitar in Jackson/Charvel's custom shop. (*See id.* at ¶ 12.) Jackson/Charvel has continuously offered for sale SAN DIMAS guitars and guitar necks in its custom shop. (*See id.*)

17. In late 2002, Donald Wade, who was then Marketing Manager for Jackson/Charvel, proposed selling a "25th Anniversary" SAN DIMAS guitar. (*See id.* at ¶ 15; *see also* Walker Decl. at ¶ 3.)

18. The marketing strategy behind using the SAN DIMAS mark with the 25th Anniversary guitar was to capitalize on customers' and the industry's association of the SAN DIMAS mark with Jackson/Charvel. (*See* Wade Decl. at ¶ 15; Walker Decl. at ¶ 3.)

19. After multiple meetings in 2002 and early 2003 between various JCMi employees, production on the 25th Anniversary SAN DIMAS guitar began in June 2003, and the guitar was offered for sale at the July 2003 NAMM trade show in Nashville, Tennessee. (*See* Wade Decl. at ¶ 15; Walker Decl. at ¶¶ 3-4.)

20. Jackson/Charvel sold hundreds of thousands of dollars of SAN DIMAS guitars—more than a quarter of a million dollars in sales—in the first 18 months since the July 2003 NAMM trade show. (*See* Walker Decl. at ¶ 4.) During this time period, SAN DIMAS guitars have been successful products and have commanded a sales price to dealers of approximately \$1,000 to \$2,000. (*See id.*) Consumers pay a retail sales price for SAN DIMAS

guitars ranging from approximately \$1,700 to \$4,000. (*See id.*) These high retail sales prices reflect the historically custom-made nature of Jackson/Charvel's SAN DIMAS guitars. (*See id.*)

21. Jackson/Charvel continues to sell the SAN DIMAS guitar and produce custom-model SAN DIMAS guitars. (*See id.* at ¶ 5.)

III. JACKSON/CHARVEL'S SAN DIMAS MARK IS WELL KNOWN BY ARTISTS, CONSUMERS, RETAILERS, AND GUITAR INDUSTRY PARTICIPANTS

22. Artists, consumers, and guitar industry participants frequently refer to Jackson/Charvel's guitars as "SAN DIMAS guitars" or "CHARVEL SAN DIMAS guitars" and have done so for years. (*See* Wade Decl. at ¶ 14.) For example, Donald Wade, Jackson/Charvel's former Vice President and Marketing Manager, recalls having a conversation with Phil Collen, who is a founding member of the rock band Def Leppard, in approximately late 2000 where Wade and Collen discussed Collen's potential purchase of a SAN DIMAS guitar. (*See id.*)

23. Indeed, Jackson/Charvel's sales staff equated the SAN DIMAS brand with the CHARVEL line of production and custom-made guitars made in Jackson/Charvel's custom shop. (*See* Declaration of Edel Diaz [hereinafter "Diaz Decl."], attached as Exhibit 2 to JCM's Response Brief, at ¶ 3.) Jackson/Charvel's marketing/sales strategy was consistent with this approach. (*See id.*)

24. From the mid-1990s to the present, consumers consistently called Jackson/Charvel requesting "SAN DIMAS guitars." (*See* Wade Decl. at ¶ 13; Diaz Decl. at ¶ 4.)

25. Jackson/Charvel received well over 200 customer calls annually referencing "SAN DIMAS guitars." (*See* Wade Decl. at ¶ 13.)

26. Jackson/Charvel also received numerous letters from retailers and/or customers referring to "SAN DIMAS guitars" or "CHARVEL SAN DIMAS guitars" from 1993 through 2003. (*See id.*)

27. Consumers consistently called Jackson/Charvel requesting SAN DIMAS guitars and/or parts. (*See* Diaz Decl. at ¶ 4.) Consumers would call Jackson/Charvel and say things like, "I want a SAN DIMAS guitar," or "Can I get a real SAN DIMAS guitar?" (*See id.*) The volume of calls referencing "SAN DIMAS guitars," "SAN DIMAS CHARVEL guitars," and/or "CHARVEL SAN DIMAS guitars" often averaged 6 to 12 calls per week. (*See id.* at ¶ 5.)

III. PRINS KNEW ABOUT JACKSON/CHARVEL'S PRIOR USE OF THE SAN DIMAS MARK AND THE SAN DIMAS MARK'S PUBLIC ASSOCIATION WITH JACKSON/CHARVEL WHEN HE RECENTLY ADOPTED HIS DESIGNATION

28. Prior to JCMi's purchase of the guitar product lines and intellectual property from AMIC's Jackson/Charvel division in October 2002, Prins had attempted to buy the Jackson/Charvel line from AMIC. (*See* Wade Decl. at ¶ 6.)

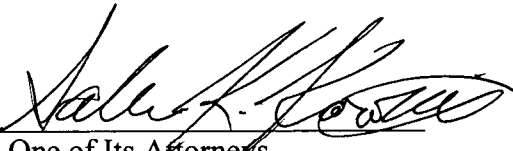
29. Prins was also a retailer, referred to as a dealer in the musical instruments industry, for Jackson/Charvel and received Jackson/Charvel's price lists/catalogs. (*See id.* at ¶ 10.)

30. Accordingly, Prins was aware of Jackson/Charvel's SAN DIMAS mark and its use in connection with guitars and guitar parts prior to his recent adoption of the SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY designation.

DATED: September 19, 2000

Respectfully submitted,

JACKSON/CHARVEL MANUFACTURING, INC.

By 
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**PETITIONER'S RESPONSE TO REGISTRANT'S STATEMENT OF
MATERIAL FACTS NOT IN DISPUTE**

Petitioner Jackson/Charvel Manufacturing, Inc. ("JCMI"), by its undersigned attorneys, hereby responds to Lloyd A. Prins' ("Prins") Statement Of Material Facts Not In Dispute, as follows:

1. On December 3, 2002, Respondent, Lloyd A. Prins, applied for registration of his SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY trademark with the U.S. Patent and Trademark Office for use in connection with International Class 015; Musical instruments, namely electric guitars and electric basses. *Pursuant to TBMP § 528.05, this document likely already of record.*

RESPONSE: JCMI does not dispute this allegation. However, JCMI disputes that Prins' date of application for the designation SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY has any bearing on this proceeding, given that Prins' supplemental registration is not entitled to constructive notice under § 22 of the Lanham Act nor constructive nationwide use as of its filing date under § 7(c) of the Lanham Act.

2. On October 7, 2003, the U.S. Patent and Trademark Office issued a certificate of registration, Reg. No. 2,772,766 to Lloyd A. Prins for his mark SAN DIMAS GUITARS THE

CALIFORNIA GUITAR COMPANY in International
Class 015. (Exhibit A attached)

RESPONSE: JCMI does not dispute this allegation. However, JCMI notes that Prins' registration is on the Supplemental Register, not the Principal Register. "It is overwhelmingly agreed that a Supplemental Register registration is evidence of nothing more than the fact that the registration issued on the date printed thereon. It is entitled to *no presumptions* of validity, ownership, use or priority." *In re Federated Department Stores Inc.*, 3 U.S.P.Q.2d 1541, 1543 (T.T.A.B. 1987) (emphasis added) (citations omitted).

3. Respondent's registered mark is bases [sic] upon a first use date of October 24, 2002. *Pursuant to TBMP § 528.05, this document likely already of record.*

RESPONSE: JCMI does not dispute this allegation. However, JCMI disputes that Prins' alleged first use date listed in his application for the designation SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY has any bearing on this proceeding. Supplemental registrations are entitled to no presumptions of use or priority. *See, e.g., In re Federated Department Stores Inc.*, 3 U.S.P.Q.2d at 1543. Accordingly, Prins' first use allegation contained in his application has no legal effect.

4. Respondent's first date of use is confirmed by the Declaration of Lloyd A. Prins, owner of the San Dimas Guitar Company. As Prins declares, the first use of his SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY trademark was in connection with the sale of his first guitar on October 24, 2002. (Exhibit B Attached)

RESPONSE: JCMI responds only that Prins' Declaration speaks for itself. Prins' Declaration does not appear to make sense as it alleges that Prins received payment from a customer and sent a product to a customer 10 days before Prins even offered any product for sale.

5. Petitioner Jackson/Charvel Manufacturing, Inc. is engaged in the business of manufacturing and selling electric guitars

and basses and is a wholly owned subsidiary of Fender Musical Instruments Corporation, a Delaware Corporation.

RESPONSE: JCMI agrees with this allegation.

6. On October 11, 2003 Petitioner filed an application, U.S. Serial No. 78312464 for the word mark SAN DIMAS to be used in International Class 015; Electric guitars. (Exhibit C Attached)

RESPONSE: JCMI agrees with this allegation.

7. In its application for registration, U.S. Serial No. 78312464, Petitioner provided a trademark specimen of its San Dimas mark as first used in July of 2003. (Exhibit D Attached)

RESPONSE: JCMI responds that its trademark application speaks for itself. The specimen provided with JCMI's trademark application was a hang-tag used on Jackson/Charvel's 25th Anniversary SAN DIMAS guitar, which was not offered for sale until July 2003. JCMI disputes that its choice of specimen for its application has any bearing on this proceeding.

8. On October 24, 2003 Petitioner filed a Petition For Cancellation to cancel Respondent's SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY trademark. *Pursuant to TBMP § 528.05, this document likely already of record.*

RESPONSE: JCMI agrees that it filed this Cancellation Proceeding on October 24, 2003.

9. The record is devoid of any evidence that Petitioner's use of its SAN DIMAS trademark pre-dates Registrant's first use date of its SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY trademark. (Exhibit E Attached)

RESPONSE: JCMI disputes this assertion and states that genuine issues of material fact concerning Jackson/Charvel's prior use of its SAN DIMAS mark preclude summary judgment. Moreover, Prins' allegation is merely an opinion without any citation to the record and cannot serve as a basis for summary judgment. Prins' only basis for this alleged "material fact" is Prins' characterization of documents produced in connection with this proceeding and Prins' bald

assertion, "I am prepared to testify that there is nothing in evidence that supports Petitioner's claim of first and continuous use of a SAN DIMAS trademark commencing in June of 1993." Conclusory assertions by a party moving for summary judgment that the nonmoving party has no evidence are insufficient to meet the moving party's initial burden. *See Celotex Corp. v. Catrett*, 477 U.S. 316, 328 (1986) (White, J., concurring). The moving party "cannot make naked assertions that genuine issues of fact do not exist." *Clancy Systems Int'l, Inc. v. Symbol Technologies, Inc.*, 953 F. Supp. 1170, 1174 (D. Colo. 1997).

10. In its Petition To Cancel, Petitioner has not alleged distinctiveness of its mark which is the subject of its application 78312464. The record is devoid of any showing of distinctiveness of Petitioner's mark either by inherent distinctiveness or acquired distinctiveness.

RESPONSE: JCMI states that this allegation is demonstrably false. JCMI did plead distinctiveness in its petition for cancellation. JCMI's petition states:

Based upon, inter alia, Jackson/Charvel's and its Predecessor's extensive use and promotion of the SAN DIMAS trademark with respect to electric guitars in interstate commerce, the SAN DIMAS mark has *acquired goodwill and public recognition* among relevant consumers, the industry, and the purchasing public.

(Petition for Cancellation at ¶ 5 (emphasis added).)

More importantly, however, JCMI disputes that evidence of the distinctiveness of its SAN DIMAS mark has any relevance to this proceeding. The Federal Circuit has held that, for a petitioner to cancel a supplemental registration, distinctiveness of the petitioner's mark is not required:


The statute does not require the anomalous result that a junior user is entitled to keep its Supplemental Registration for a descriptive term in which it has not established secondary meaning (as evidenced by registration on the Supplemental Register) because a *prior* user cannot show secondary meaning in that term either.

Books on Tape, Inc. v. Booktape Corp., 836 F.2d 519, 520 (Fed. Cir. 1987). As the owner of a supplemental registration has not shown distinctiveness of its designation in order to gain its registration, a prior user of the same or similar term should not have to show distinctiveness in order to prevail in a cancellation proceeding. *See id.* Plainly, distinctiveness is not required to cancel a supplemental registration, such as Prins'. Accordingly, this allegation does not have any bearing on this Cancellation Proceeding.

DATED: September 19, 2005

Respectfully submitted,

JACKSON/CHARVEL MANUFACTURING, INC.

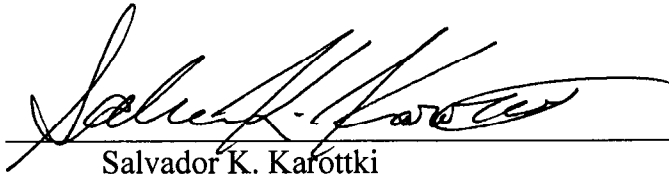
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CERTIFICATE OF SERVICE

The undersigned, an attorney, certifies that on September 19, 2005, he caused a copies of **Petitioner's Response in Opposition to Registrant's Motion for Summary Judgment, Petitioner's Response to Registrant's Statement of Material Facts not in Dispute, and Petitioner's Statement of Material Undisputed Facts** to be served by Express Mail delivery upon the following:

Lloyd A. Prins
San Dimas Guitar Company
2323 Via Saldivar
Glendale, CA 91208



Salvador K. Karottki

CERTIFICATE OF MAILING 37 C.F.R. 1.10

I hereby certify that the enclosed Petitioner's Response in Opposition to Registrant's Motion for Summary Judgment, Petitioner's Response to Registrant's Statement of Material Facts not in Dispute, and Petitioner's Statement of Material Undisputed Facts are being deposited with the United States Postal Service with sufficient postage, using United States Postal Service's Express Mail Post Office to Addressee service, addressed to: U.S. Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia, 22313, on the date indicated below.

Dated: September 19, 2005


Salvador K. Karottki